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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/792,076 | 03/02/2004 | Elaine Lim | 1001.1766101 | 4203 |
| 28075 | 7590 | 06/05/2006 | EXAMINER | |
| CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420 | | | THANH, LOAN H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3763 | |

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/792,076

Applicant(s)

LIM ET AL.

Examiner

LoAn H. Thanh

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3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/14/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-28, 30 and 32-39 is/are pending in the application.
- 4a) Of the above claim(s) 5, 12-16, 20-27, 30, 36 and 40-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-11, 17-19, 27, 28, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) 7, 32-33, 38-39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

The Musbach rejection under 35 USC 102 (e) has been withdrawn in view of applicant's amendment as filed on 03/14/06.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4,6,8-9,17, 28-29,31,34-35 rejected under 35 U.S.C. 102(b) as being anticipated by Roberts et al. (USPN 5,545,209).

Roberts et al. disclose a balloon catheter comprising an elongated shaft 20 having a balloon 10 disposed at the distal region of the shaft, wherein the balloon has a first expansion configuration wherein the balloon first diameter is expanded in the distal portion and in the proximal portion is in a collapsed configuration and a second expanded configuration where the first and second diameter of the expanded balloon is substantially the same. See figures 1-6. Specifically figure 3 and 6. Roberts et al. disclose a balloon catheter for insertion into a patient wherein the shaft comprises a multilumen catheter having an inflation lumen 21 and a guidewire lumen 19. The balloon proximal portion is releasably attached to the shaft by epoxy adhesive. The term "releasably" or "releasable" is considered to be intended use. See columns 4, 6, 7-

8,12. This rejection is being maintained. Applicant's releasable attachment is disclosed in the specification as adhesive and claimed as an adhesive in claim 8.

Claims 1-4,6,9,28-29, 34, 35, 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Briscoe et al. (USPN 6,458,096).

Briscoe et al. disclose a balloon catheter having a balloon 46 disposed on the distal region of the shaft 14. The balloon is releasable at the distal portion of the balloon when the differential pressure is exceeded. See abstract, Figures 1-4, columns 2 and 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. (USPN 5,545,209) in view of Stevens (USPN 4,798,586).

Roberts et al. disclose the invention as substantially claimed. See above. Roberts et al. disclose a balloon catheter for insertion into a patient. Robert et al. is silent to the radiopaque markers disposed on the shaft. Stevens discloses a balloon catheter for insertion into a patient with radiopaque markers on the shaft for monitoring balloon catheterization procedure. See column 3, line 67 to col. 4 lines 1-2. It would have been obvious to one of ordinary skill in the art at the time the invention was made

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to modify the shaft of Roberts et al. with radiopaque markers disposed on the shaft as taught by Stevens in order to provide monitoring and confirmation of the location of the balloon within the patient body. This would assist the physician to guide the balloon to the target location.

Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. (USPN 5,545,209) in view of Sugiyama et al. (USPN 4,964,853).

Roberts et al. disclose the invention as substantially claimed. See above. Roberts et al. disclose a balloon catheter for insertion into a patient having a multilumen catheter comprising an inflation lumen 21 and a guidewire lumen 19. Robert et al. is silent to the specific configuration of the shaft as claimed. Sugiyama et al. disclose a balloon catheter for insertion into a patient having a multilumen configuration of the shaft comprising an inflation lumen and guidewire lumen. It would have been obvious to one of ordinary skill in the balloon catheter arts to modify the configuration of the multilumen catheter to be coaxial and elongated from the proximal to distal region as claimed as a mere design choice performing equivalent functions to provide an inflation and guidewire lumen.

Allowable Subject Matter

Claims 7,32-33,38-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 03/14/06 have been fully considered but they are not persuasive. With respect to the term "releasably attached", it is considered intended use. If the user so wishes to release the attachment the device would be capable of having the balloon released. This is made possible in manufacturing the device. Applicant's device is releasably attached by an adhesive and the prior art also teaches adhesive. Applicant is to distinguish from the prior art by including more structural limitation which applicant has not included in the independent claim. The term is given the broadest interpretation and has not ignored any limitations and has given patentable weight in the broadest interpretation.

Further, one skilled in the art would know that when the balloon is in an uninflated stage, the balloon is either wrapped or folded or directly on the shaft. Although the figures may not clearly show this in all the figures, it is well within the knowledge of one in the art of balloon inflation and as evidenced in figures 13a 14b of Roberts et al. See also figures 1-11a.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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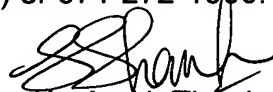
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LoAn H. Thanh whose telephone number is (571) 272-4966. The examiner can normally be reached on Mon. - Fri. (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



LoAn H. Thanh
Primary Examiner
Art Unit 3763

LT